

### ***REMARKS***

This amendment responds to the office action mailed October 31, 2007. In the office action the Examiner:

- objected to claims 49, 50, 54, 59, 61, 65, 69, 70, 74 and 79 for containing informalities;
- rejected claims 61-69, and 81 under 35 U.S.C. 101 as being directed to non-statutory subject matter;
- rejected claims 45, 46, 49-57, 59-66, 68-75, 77-81 under 35 U.S.C. 102(b) as anticipated by Comer et al., (“Conversation-Based Mail” hereinafter “Comer”); and
- rejected claims 47, 48, 58, 67 and 76 under 35 U.S.C. 103(a) as being unpatentable over Comer et al. (“Conversation-Based Mail”) in view of Kennedy (US 6,330,589).

Pending claims include: 45-58, 61-78, 81.

### ***AMENDMENTS TO CLAIMS***

Claims 59, 60, 79, 80 are cancelled.

Claims 49, 50, 61, and 70 are amended to show “the list of conversations” to correct an informality.

Claims 65, 74 are amended to show “the unique subset of the plurality of electronic messages” to correct an informality.

Claim 69 is amended to show “The system” to correct an informality.

Applicant thanks Examiner for pointing out these informalities.

Claims 61, 68 and 81 are amended to add hardware elements. Support can be found in at least Figure 19 of the application.

Claims 45, 49, 68, 77, and 81 are amended to state that they are client-based, and that they transmit a query over a network. Support can be found at least in Figures 1, 10, paragraph 83, and paragraph 0113 of the application.

Claims 50, 61, 70, are amended to state that they are server-based, and that they transmit a list of conversations over a network for display on a client. Support can be found at least in Figures 1, 10, paragraph 83, and paragraph 0115 of the application.

Claims 52, 63 and 72 are amended for clarity, by replacing "not including" with "other than".

*Claims 61-69, 81 and 35 U.S.C. 101*

Claims 61, 69 and 81 have been amended to add hardware elements. The addition of these hardware elements overcomes the 35 U.S.C. 101 rejection of claims 61-69 and 81. Applicant respectfully requests that the rejection be removed.

*Claims 45, 46, 49-57, 59-66, 68-75, 77-81 and 35 U.S.C. 102*

For a reference to anticipate a claim under 35 U.S.C. 102, the reference must teach every element of the claim (MPEP 2131).

Claim 45 states:

A method for searching messages in a conversation-based message system, comprising:

**at a client:**

receiving a query from a requestor;

**transmitting the query over a network to a conversation management system;**

receiving from the conversation management system a list of conversations, each of the conversations in the list having a respective conversation identifier, and **wherein each conversation comprises one or more messages sharing a common set of characteristics that meet first predefined criteria;** and

presenting at least a portion of the list of conversations to the requestor.  
(emphasis added)

**Comer et al. teaches conversation processing at a client.**

Comer et al. was published in 1986, when computer networks were very primitive compared to the World Wide Web and the Internet of today. The system described in Comer is entirely client based. In Comer, the conversations are sorted/ranked at the client and stored at the client. Thus, if a user moves from a first client device to a second client device, the user cannot access his/her conversations as they appeared on the first client device, without having to remotely log on the first client. See page 10, bottom paragraph of Comer et al., titled “5.1 Distributed Conversations.” Comer et al. states “a particular host is designated as each user’s home machine.” In Comer, a host is another term for a client, i.e., “home machine”.

The present claims (excluding claim 49) require server-based processing of queries and generation of a list of conversations, and transmission of that list over a network to a client. Some of the present claims (including claims 45, 49, 68, 77, 81) also explicitly

require transmitting a query from a client to a server for processing. This allocation of processing effort between the server and client permits thin clients, i.e., the processing burden on the client is reduced, allowing a client to function on devices such as cellphones, portable digital assistants (PDAs), pager devices, etc. This greatly adds to the mobility and usefulness of the message system of the present claims. Such an allocation of processing effort, and the resulting mobility benefits, are not taught or suggested by Comer et al.

Further, the message system of the present claims permits a user to log on to the message system from a variety of clients (e.g., a cellphone, a pager, a PDA, a home computer, office computer etc.) and get a consistent view of email messages and conversations across all client platforms. This is very advantageous to a user, as their messages and conversations have a consistent context and order across platforms. Such a consistent view of messages is not taught or suggested by Comer et al.

**Comer et al. does not teach transmitting a query to a conversation management system.**

In the office action of October 31, 2007, the Examiner cited page 3, lines 38-40 and page 18, lines 15-17 as teaching the “transmitting the query” of the present claims. Nowhere in the cited paragraph is the concept of transmitting discussed. Further, a text search of Comer reveals that the words “transmit” and “transmitting” do not appear. Comer does state (page 4, lines 13-15) “The service should also provide a query mechanism that cuts across group boundaries searching for messages with a particular sender, subject etc.” However, the query mechanism in Comer is resident solely on the client; it is for this reason that Comer fails to teach, mention or suggest “transmitting over a network a query to a conversation management system.”

For at least the above reasons, the Comer et al. reference does not anticipate the present claim 45. For at least the same reasons, independent client-based claims 49, 68, 77, and 81 are not anticipated by Comer et al.

For similar reasons (at least the corollary of the client-based reasons above), the server-based claims 50, 61, and 70 are not anticipated by Comer et al. Each of the server based independent claims states “transmitting over a network to a client for display the list of conversations,” which is not taught by Comer et al.

For at least the same reasons as above, all dependent claims are not anticipated by Comer et al.

Applicant respectfully requests that the 102 rejection be withdrawn.

*Claims 47, 48, 58, 67 and 76 under 35 U.S.C. 103(a)*

**Kennedy teaches conversation processing at a client.**

Like Comer et al., Kennedy is client based. Figure 3 of Kennedy shows message manager program module 37 is located at the client: “message manager program module 37 for facilitating message management and operation of the database,” see column 8 lines 30-32. Figure 8 of Kennedy shows that **after** the message download operation (525), the conversations are processed (545, 550, 555, 570). See column 20, lines 46-67: “In step 525, download operations are performed to download the message from the server to the client.” In Kennedy, the processing of messages into a conversation is performed at a client, not at a server.

Thus, for at least the same reasons as Comer et al., Kennedy does not teach the server-based conversation processing of the present claims

**Kennedy does not teach transmitting a query to a conversation management system.**

Kennedy teaches “manag(ing) conversation threads generated from email or news messages.” See title. Kennedy does not teach transmitting a query to a conversation management system. In fact, Kennedy does not teach a search or a query at all. A text search of Kennedy reveals that the words “search” and “query” are not present. Kennedy, alone or in combination with Comer et al., cannot teach the query limitations of independent claim 45.

In addition, there is no combination of the client-based Comer et al. and Kennedy systems that produces the server-based conversation processing, or client-based query submission to a server, of the present claims. Neither Comer et al. nor Kennedy, alone or in combination, teach the server-based conversation searching aspect of the present claims, where the server-generated conversation results include the predefined criteria, and are “transmitt(ed) over a network to a client for display”. The client conversation-based mail of Comer cannot be merged with the client email and news manager of Kennedy to create server generated conversation results based on searches submitted from a client.

For at least the above reasons, independent claims 45, 50, 56, 68, 70, 77, and 81 are not taught by the combination of Kennedy and Comer et al. Thus, for at least the same reasons, the dependent claims 47, 48, 58, 67 and 76 cannot be taught by the combination of Kennedy and Comer et al.

Applicant respectfully requests that the 103 rejection be withdrawn.

In light of the above amendments and remarks, the Applicant respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (650) 843-4000, if a telephone call could help resolve any remaining items.

Respectfully submitted,

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